

The opinion in support of the decision being entered today was **not** written for publication  
and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

**Ex parte OLAF VANCURA**

Appeal No. 2005-1374  
Application No. 09/875,753

ON BRIEF



Before RUGGIERO, DIXON, and LEVY, **Administrative Patent Judges**.  
**DIXON, Administrative Patent Judge.**

**DECISION ON APPEAL**

This is a decision on appeal from the examiner's final rejection of claims 1, 3, 8-10, 19, 24, 25 and 30, which are all of the claims pending in this application.

We REVERSE and make a NEW GROUNDS OF REJECTION.

## BACKGROUND

Appellant's invention relates to a knowledge-based casino game and method therefor. An understanding of the invention can be derived from a reading of exemplary claims 1, 19 and 25, which appear below.

1. A method for playing a casino game comprising the steps of:  
receiving a wager,

playing an underlying game of chance,

playing a knowledge-based bonus game using answers from a player in combination with the underlying game of chance, the combined knowledge-based bonus game with the underlying game of chance having a house advantage within a predetermined range.

19. A method for playing a combined knowledge-based bonus game with an underlying casino game of chance, the method comprising the steps of:

receiving a wager,

playing the underlying casino game of chance, stopping play of the underlying casino game of chance,

playing the knowledge-based bonus game when the underlying casino game of chance is stopped, the steps of playing the knowledge-based game at least having the steps of:

(a) providing at least one query to the player in the knowledge-based game,

(b) receiving at least one answer from the player in response to the provided at least one query,

(c) paying the player based upon the at least one answer by the player providing a house advantage within a predetermined range for the

combined knowledge-based bonus game and underlying casino game, the predetermined range having a set limit based at least upon all answers to all queries in the knowledge-based game are always correct and the wager.

25. A method for playing a combined knowledge-based bonus game with an underlying casino game of chance, the method comprising the steps of: playing the underlying casino game of chance, playing the knowledge-based bonus game in combination with the underlying game, the steps of playing the knowledge-based game at least having the steps of:

(a) providing at least one query to the player in the knowledge-based game,

(b) receiving at least one answer from the player in response to the provided at least one query, the combined knowledge-based bonus game with the underlying casino game having a house advantage in a range from a first set limit based on all answers to all queries are correct and a second limit based on all answers to all queries are guessed.

The prior art of record relied upon by the examiner in rejecting the appealed

claims:

Thompson	5,178,545	Jan. 12, 1993
Keller, Jr.	5,718,429	Feb. 17, 1998
Walker et al. (Walker)	6,193,606	Feb. 27, 2001
		(filed Jun 30, 1997)
Evans	GB 2,197,974	Jun. 2, 1988
Claypole et al. (Claypole)	GB 2,262,642	Jun. 23, 1993

The prior art relied upon by the Board<sup>1</sup> in rejecting claims 1, 3, and 9 below:

Walker et al. (Walker)	6,193,606	Feb. 27, 2001
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<sup>1</sup> We note that no dates are provided by the examiner with the references attached to the Examiner's Answer. The dates presumed are from the internet. The examiner should determine the correct dates and fill out a PTO-892 with correct information.

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Vancura, Smart Casino Gambling: How to Win More and Lose Less, Chapter 2: How Do Casinos Make Money, pp. 23-33, Index Publishing Group, Inc. (1999-presumed.)

Martinez, Managing Casinos: A Guide for Entrepreneurs, Management Personnel and Aspiring Managers, pp. 40-43, Barricade Books. (1995-presumed.)

Kilby et al. (Kilby), Casino Operations Management, John Wiley & Sons, Inc., Chapter 7: Slot Management, pp. 103-127 and Chapter 13: Table Game Hold as a Management Tool, pp. 213-225. (1998-presumed.)

Claims 1, 3, 8-10, 18, 19, 24, 25, and 30 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1, 3, 8, 9, and 18 stand rejected under 35 U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 3, and 18 stand rejected under 35 U.S.C. § 102 as being anticipated by Keller or Evans.

Claims 1, 3, 8-10, 18, 19, 24, 25, and 30 stand rejected under 35 U.S.C. § 102 as being anticipated by Walker.

Claims 1, 3, 8-10, 18, 19, 24, 25, and 30 stand rejected under 35 U.S.C. § 102 as being anticipated by Claypole.

Claims 8-10, 19, 24, 25, and 30 stand rejected under 35 U.S.C. § 103 as being unpatentable over Keller or Evans in view of Thompson.

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Rather than reiterate the conflicting viewpoints advanced by the examiner and appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 17, mailed May 16, 2003) for the examiner's reasoning in support of the rejections, and to appellant's brief (Paper No. 15, filed Feb. 24, 2002) and reply brief (Paper No. 18, filed Jul 10, 2003) for appellant's arguments thereagainst.

## OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Appellant has elected to group the claims into three separate groupings. Therefore, we will select a single claim from each group as the representative claim. Only those arguments actually made by appellants have been considered in this decision. Arguments that appellant could have made but chose not to make in the brief have not been considered. We deem such arguments to be waived by appellant [see 37 CFR § 41.37(c)(1)(vii) effective September 13, 2004 replacing 37 CFR § 1.192(a)]. We will consider the appealed claims separately only to the extent separate arguments for patentability are presented. Any dependent claim not separately argued will stand or fall with its base claim. **Note In re King**, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); **In re Sernaker**, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983).

**35 U.S.C. § 112, FIRST PARAGRAPH**

As our reviewing court states, "[t]he terms used in the claims bear a 'heavy presumption' that they mean what they say and have the ordinary meaning that would be attributed to those words by persons skilled in the relevant art." **Texas Digital Sys., Inc. v. Telegenix, Inc.**, 308 F.3d 1193, 1202, 64 USPQ2d 1812, 1817 (Fed. Cir. 2002) **cert. denied**, 123 S.Ct. 2230 (2003).

Moreover, the intrinsic record also must be examined in every case to determine whether the presumption of ordinary and customary meaning is rebutted. Indeed, the intrinsic record may show that the specification uses the words in a manner clearly inconsistent with the ordinary meaning reflected, for example, in a dictionary definition. In such a case, the inconsistent dictionary definition must be rejected. [Citation omitted.] ("[A] common meaning, such as one expressed in a relevant dictionary, that flies in the face of the patent disclosure is undeserving of fealty."); **Liebscher v. Boothroyd**, 258 F.2d 948, 951, 119 USPQ 133, 135 (CCPA 1958) ("Indiscriminate reliance on definitions found in dictionaries can often produce absurd results."). In short, the presumption in favor of a dictionary definition will be overcome where the patentee, acting as his or her own lexicographer, has clearly set forth an explicit definition of the term different from its ordinary meaning. [Citations omitted.] Further, the presumption also will be rebutted if the inventor has disavowed or disclaimed scope of coverage, by using words or expressions of manifest exclusion or restriction,

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representing a clear disavowal of claim scope. **See Teleflex Inc. v. Ficosa North America Corp.**, 299 F.3d 1313, 1324, 63 USPQ2d 1374, 1380. **Texas Digital Sys., Inc v. Telegenix, Inc.**, 308 F.3d 1193, 1204, 64 USPQ2d 1812, 1819.

Our reviewing court has recently clarified the usage of intrinsic and extrinsic evidence for claim interpretation in **Phillips v. AWH Corporation**, Fed. Cir. Appeals 03-1269, - 1286, Slip Opinion at pages 30-31. (July 12, 2005). The Court stated that

In Vitronics, [**Vitronics Corp. v. Conceptronic, Inc.**, 90 F.3d 1576, 39 USPQ2d 1573 (Fed. Cir. 1996)] this court grappled with the same problem and set forth guidelines for reaching the correct claim construction and not imposing improper limitations on claims. 90 F.3d at 1582. The underlying goal of our decision in Vitronics was to increase the likelihood that a court will comprehend how a person of ordinary skill in the art would understand the claim terms. See id. at 1584. In that process, we recognized that there is no magic formula or catechism for conducting claim construction. Nor is the court barred from considering any particular sources or required to analyze sources in any specific sequence, as long as those sources are not used to contradict claim meaning that is unambiguous in light of the intrinsic evidence. See id. at 1583-84; Intel Corp. v. VIA Techs., Inc., 319 F.3d 1357, 1367 (Fed. Cir. 2003).

Appellant has clearly identified and specifically defined certain terms in the specification and we are obligated to interpret these terms as specifically defined and give those other limitations their ordinary meaning.

The Examiner appears to be requiring that Appellants set forth some special indication that they are acting as their own lexicographer or providing a special definition for the phrase "in combination with." We find there is no such requirement in the statutes, rules, or case law. Rather, it is only required that any special meaning

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assigned to a term "must be sufficiently clear in the specification that any departure from common usage would be so understood by a person of experience in the field of the invention." **Multiform Desiccants Inc. v. Medzam Ltd.**, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998). **See also Process Control Corp. v. HydReclaim Corp.**, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). We find no special definition or need therefor in the present disclosure and claims.

The examiner maintains that the claim language "in combination with" implies that the game of chance and the trivia game are played simultaneously rather than sequentially as disclosed in the specification. (Answer at pages 2-4.) Appellant argues that the examiner has not presented a *prima facie* case of a lack of enablement.<sup>2</sup> (Brief at pages 6-15.) Giving the phrase its ordinary meaning, we find that "combination" means the action of combining two or more different things in some manner. The examiner maintains that "[t]his is a scope of claim problem." (Answer at page 3.) While we agree with the examiner that there is a scope of claim problem with appellant's claim language, we find that the claim language is quite broad, and we shall address that issue with respect to 35 U.S.C. § 103 in our new grounds of rejection.

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<sup>2</sup> Additionally, appellant argues that the examiner has not clearly set forth whether the grounds of rejection is based upon the written description requirement or the enablement requirement. (Brief at pages 6-15.) We find that the examiner had used varied terminology that may have caused confusion, but since the examiner had incorporated the prior rejection based upon enablement, we find it clear that the rejection has remained a rejection based upon enablement and that any time appellant may have clarified the basis of the rejection with a telephone call to the examiner. We find no lack of due process on the record.

From our review of appellant's specification, we find the specification to have adequate disclosure to enable one skilled in the art to make and/or use the claimed invention. While the examiner has identified a perceived problem with whether the two games are played simultaneously or sequentially, we find that either way, it is the computation and setting of the house advantage so as to be within a preset range for the two outcomes/results of the two individual games. The two outcomes produce a desirable advantage for the house. We find that the language of independent claim 1 while broad, has been adequately described to enable one skilled in the art to make and/or use the claimed invention. Therefore, we cannot sustain the rejection of independent claim 1 and its dependent claims. Similarly, we find adequate disclosure for further limited independent claims 19 and 25, and we will not sustain the rejection of independent claims 19 and 25 and their dependent claims.

#### **35 U.S.C. § 112, SECOND PARAGRAPH**

After reviewing Appellant's disclosure, it is apparent to us that the claim language refers to any combination of a game of chance and a knowledge-based trivia game as these two terms have been clearly defined in appellant's specification at page 6. While the claims are perhaps broader by referring to the two games "in combination with" each other rather than sequentially or simultaneously, we find no uncertainty or lack of specificity exists as asserted by the Examiner. Similarly, while the use of the terminology "in combination with" or "combined" are broad recitations, we find no

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ambiguity in the use of such language. The breadth of a claim is not to be equated with indefiniteness. **In re Miller**, 441 F.2d 689, 692, 169 USPQ 597, 600 (CCPA 1971).

It is our view that the skilled artisan, having considered the specification in its entirety, would have no difficulty ascertaining the scope of the invention recited in independent claim 1 and its associated dependent claims. Therefore, the rejection of claims 1, 3, 8, 9, and 18 under the second paragraph of 35 U.S.C. § 112 is not sustained.<sup>3</sup>

### 35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

**Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating

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<sup>3</sup> While the examiner has not included dependent claim 10 which includes the same limitations as independent claim 1, we would similarly reverse a rejection of this claim on the same basis.

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reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); **cert. dismissed**, 468 U.S. 1228 (1984); **W.L. Gore and Associates, Inc. v. Garlock, Inc.**, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), **cert. denied**, 469 U.S. 851 (1984).

We consider first the examiner's 35 U.S.C. § 102 rejection of claim 1 based upon Keller, Evans, Walker, and Claypole. With respect to independent claim 1, the representative claim for Appellant's first suggested grouping of claims subject to this rejection, the examiner indicates how the various limitations read on the recited limitations and relies upon inherency with respect to the lack of any disclosure of a house advantage or a house advantage "within a predetermined range." (Answer at pages 5-8.)

After reviewing the four references in light of the arguments of record, we are in agreement with the Examiner that Appellant's arguments are not commensurate with the scope of representative claim 1 and merely reiterate the language of the claims

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repeatedly. In our view, Appellant's arguments improperly attempt to narrow the scope of the claim by implicitly adding disclosed limitations which have no basis in independent claim 1. **See In re Morris**, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997).

"Deficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" **In re Zurko**, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697(Fed. Cir. 2001). Furthermore, "the Board's findings must extend to all material facts and must be documented on the record, lest the 'haze of so-called expertise' acquire insulation from accountability." **In re Lee**, 277 F.3d 1338, 1345, 61 USPQ2d 1430, 1435 (Fed. Cir. 2002). Here, we find the Examiner's arguments to be supported merely by the Examiner's own expertise instead of the evidence of record and the teachings of prior art which are required in order to establish a **prima facie** case of anticipation or obviousness.

On page 5 of the answer, the examiner refers the house advantage as a fundamental truth along with its variables. We disagree with the examiner's conclusion and find that while well known, the designer need not always design or program the casino game to have an advantage to the house whereas a game or machine may be used as a noise maker or machine to entice players into the casino thereby having a house disadvantage, but paying dividends to the house by advertising or enticing others to start to play. On page 16, of the answer, the examiner refers to references that have not been applied in the rejection under appeal. These references have been given no

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consideration since they were not included in the statement of the rejection or eligible in a combination under 35 U.S.C. § 102. **See Ex parte Raske**, 28 USPQ2d 1304, 1305 (Bd. Pat. App. & Int. 1993).

Here, we find the Examiner's arguments to be supported merely by the Examiner's own expertise instead of the evidence of record and the teachings of prior art which are required in order to establish a *prima facie* case of anticipation. Accordingly, we do not sustain the 35 U.S.C. §§ 102 and 103 rejections of any of claims. A discussion of the applied prior art is below.

#### **WALKER**

While Walker teaches a combination of a slot machine and a trivia game with the ability to access higher rewards (Walker abstract), we find that Walker does not teach the use of a house advantage within a predetermined range as required by the language of all of the independent claims. Walker teaches that the payoff from the game of chance is either raised or reduced based upon a correct or incorrect answer to the trivia question. From our review of the teachings of Walker, we find that Figure 10 teaches that the house advantage or the payoff would vary. Therefore, we find that the payoff would be variable for the game of chance and would be different for the combination of the game of chance with the trivia game. Therefore, there would have been a range of payouts since it would change for different levels of participation.

We find that the examiner makes one material error with respect to "casino games" that these games of chance ALL have a consideration of house

percentage/advantage and that it is "inherent" and a "fundamental truth." (Answer at page 5.) While it is true that house percentage/advantage is essential to the financial well being of a casino, we do not find that ALL machines and games must "necessarily" have a positive house advantage since some machines are used as noise makers and used as attractions rather than as moneymakers. While we can agree that house advantage is a consideration, we cannot agree with the examiner that the house advantage would be within a predetermined range and that range would have set limits based on the correctness of the answers to the trivia questions as recited in independent claim 1. Therefore, we cannot sustain the rejection of independent claims 1, 19, and 25 and their dependent claims based on Walker.

Additionally, we note that the examiner has argued throughout the prosecution that many of the features of the claimed invention are old and well known or known in the art, but we note that one of the requirements to support a rejection under 35 U.S.C. § 102 is that a single prior art reference must teach or disclose the totality of the claimed invention. Therefore, the mere fact that certain facts were old and well known in the (pertinent) art is not sufficient to support a finding of anticipation unless those additional facts or features MUST NECESSARILY have been present in the applied reference or teaching. Additionally, the examiner cites "Smart Casino Gambling," by Olaf Vancura that "almost all games enjoy[s] a positive expectation" to support a finding that the house advantage was known and present. (Answer at page 16.) Here, we agree with the quotation that almost all games enjoy a positive house advantage, but

not necessarily all games. Therefore, we find that it need not be inherent, but may or may not have been obvious that it is desirable to have a positive house advantage in all or most of the casino games. Accordingly, we cannot sustain the rejection of the independent claims based upon the teachings of Walker since Walker does not teach all of the claimed limitations.

#### **CLAYPOLE**

While Claypole teaches the use of game of skill, such as a quiz game, (Claypole at pages 3, 4, and 7), Claypole does not specifically address that the outcome of the combination of game of chance and game of skill would have a house advantage within a predetermined range. From our review of the teachings of Claypole, we find no clear discussion that there is a house advantage within a predetermined range. From our review of the Claypole reference, we find that Claypole is silent as to the payoffs and the house advantage. We find Claypole to be a general teaching of multiple variations on combined games with little detail thereto. The examiner again maintains that it would be inherent that the house advantage would have been present. The examiner maintains that “[e]ach of the applied references inherently have a predetermined range and the range that is deemed acceptable to commercial viability is subjective.” (Answer at page 8.) We agree with the examiner in general, but find within the reference neither a teaching of a house advantage within a predetermined range with nor a teaching of the house advantage being any more than a singular value. Therefore, we cannot agree with the examiner that the claimed house advantage would have been inherent

within the teachings of Claypole. Accordingly, we cannot sustain the rejection of the independent claims based upon the teachings of Claypole since Claypole does not teach all of the claimed limitations.

#### **KELLER**

Keller teaches the combination of the game of chance tied by the use of a payoff of a non-monetary token which may only be used to obtain access to a physical or mental game of skill. If the player is successful in the game of skill, the individual is awarded a prize based upon the indicium on their token. Here, we agree with appellant that the Keller game combination is more of a combination for entertainment in areas with limited ability to play games of chance for monetary gain. (Brief at pages 21 and 22.) Appellant argues that Keller does not teach a “casino game,” but rather is a bifurcated arcade game (Brief at page 23.) While we agree with appellant concerning the payoff from the game of chance in tokens in Keller, we find no limitation on what the payoff of the game of chance must be in the instant claims. Here, Keller has two separate and different payoffs and the winning token in the game of chance must be used as an entry into the game of skill. Therefore, Keller teaches the use of two payoffs, but requires that first payoff to be used to enter the game of skill. While it is not the same as in appellant's disclosed method, we agree with the examiner that it is sufficient to meet the limitations of the independent claim 1 with respect to the steps of playing a game.

What we do not find is any discussion of house advantage in the teachings of Keller. Again, the examiner maintains that one skilled in the art would have recognized that the casino game of Keller would be profit driven and the game is considered to inherently have a house advantage within a predetermined range. (Answer at page 11.) Again, we agree with appellant that the examiner has gone beyond the express disclosure of Keller and made assumptions which do not have to necessarily occur. Here, the examiner does not identify why the house advantage would have necessarily been within a range or rather a singular value. Therefore, we cannot agree with the examiner that the claimed house advantage within a predetermined range would have been inherent within the teachings of Keller. Accordingly, we cannot sustain the rejection of independent claim 1 and dependent claims 3 and 18 based upon the teachings of Keller since Keller does not teach all of the claimed limitations.

**EVANS**

Again, as with the teachings of Walker, Claypole and Keller, we find no teaching or discussion of the use of a house advantage within a predetermined range or as a range rather than as a singular value. Again, the examiner maintains that casino games are known to have a house percentage within a predetermined range and that the total prizes awarded would not be greater than the total amount of monies received at the play of the game. (Answer at page 17.) Here again, we cannot agree with the examiner that the house advantage must necessarily have been a variable quantity that is within a predetermined range having set limits based on the correctness of the

answers and the wager, as recited in the language of independent claim 1. Therefore, we cannot agree with the examiner that the claimed house advantage would have been inherent within the teachings of Evans. Accordingly, we cannot sustain the rejection of independent claim 1 and dependent claims 3 and 18 based upon the teachings of Evans since Evans does not teach all of the claimed limitations.

### 35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. See *In re Rijckaert*, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. See *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of

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doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See** **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g.,** **Grain Processing Corp. v. American Maize-Props. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations in dependent claims 8, 9 and 10 and independent claims 19 and 25. The examiner continues to maintain that the house advantage is "inherent" in casino games and that the setting of the house advantage as in the dependent claims is an obvious matter of design choice. (Answer at pages 5 and 6 with respect to the anticipation and page 8.) While the examiner has based the rejection under 35 U.S.C. § 103, the examiner continues to maintain that house advantage is inherent and the specific setting of the house advantage is an obvious matter of design choice. We again maintain that the house advantage is not inherent, but may or may not be deemed to be an obvious design consideration as also advanced by the examiner. Yet, we do not find any discussion of having the house advantage as a variable quantity within a set range of predetermined values. Therefore, we cannot sustain the rejection of independent claims 19 and 25 since the examiner relies upon the same bases for the rejection as discussed above with respect to the rejections under 35 U.S.C. § 102 which are not resolved or addressed by the examiner's addition of the teachings of Thompson and an attempt to invoke the additional facts which are common knowledge and elements of design in the modification of the base teachings. Accordingly, we do not find that the examiner has established a *prima facie* case of obviousness, and we cannot sustain

the rejection of independent claims 19 and 25 and their respective dependent claims 24, and 30 along with dependent claims 8-10 which depend from independent claim 1.

#### **NEW GROUNDS OF REJECTION**

Claims 1, 3, and 9 are rejected under 35 U.S.C. § 103 as being unpatentable over Walker in view of the teachings of Vancura, Martinez, or Kilby.

In determining novelty, the first inquiry must be into exactly what the claims define. *In re Wilder*, 429 F.2d 447, 450, 166 USPQ 545, 548 (CCPA 1970). Similarly, a section 103 analysis begins with a key legal question -- what is the invention claimed? *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1567, 1 USPQ2d 1593, 1597 (Fed. Cir. 1987).

Here, the name of the game is the claim. We look to the language of independent claim 1 and find that the relevant limitation is "playing a knowledge-based bonus game using answers from a player in combination with the underlying game of chance, the combined knowledge-based bonus game with the underlying game of chance having a house advantage within a predetermined range." Here, we find that the limitation as to the game being played and the house advantage therein is akin to an intended field of use preamble which is not realized by the remainder of the claim. In independent claim 1 there is no limitation as to what the range is or that the house advantage is variable and maintained within the range as disclosed in the specification at page 4, lines 18-22. There it states that the:

knowledge-based bonus games . . . are designed to maintain the house advantage in a range from when all answers to all queries in the knowledge-based bonus game are always correct from the player to the other extreme when all answers to all queries in the knowledge-based bonus game are always being guessed at by the player.

In the instant claim language, we find that the claim may reasonably be interpreted to have a house advantage that is always the same and that the value would necessarily be within the range of 0.00000001 to 100 since every set value is within a set range of possible values. Here, we find that independent claim 1 is very broad.

While we agreed with appellant that the teachings of Keller and Evans do not necessarily and inherently teach a casino game with a house advantage within a predetermined range, we do agree with the examiner's conclusions therewith that it would have been obvious to one of ordinary skill in the art at the time of the invention that skilled artisans would have made it one of the major design criteria to assure that there is worst case house advantage that is profitable. And that this value would necessarily be within a predetermined range or a set value.

While not what appellant may have intended the claim interpretation to be, we do not find the above interpretation to be an unreasonable interpretation in light of appellant's broad claim language. Moreover, the instant independent claim does not require that there be any payout, or how the two games are combined, or how the answers from the knowledge-based bonus game are used with the underlying game of chance. We find that independent claim 1 is very broad.

With this said, we find that Walker teaches the use of a trivia game (knowledge-based bonus game) in combination with a slot machine for use in a casino. (Walker at col. 1 and abstract.) Walker discloses that the questions for the trivia game are obtained from a remote location, we find no requirement in the language of independent claim 1 which would preclude this remote access. Walker discloses in Fig. 9 a table/payout database 900 having the schedule for payout for the combined game of chance and the knowledge-based bonus game. (Walker at col. 6.) Walker also discloses an enhanced payout database 1000. Walker discloses the corresponding method for playing the combined game at columns 6-7 and states that “[b]ased on the identified slot outcome, as well as the player’s answer to the trivia question, the CPU 310 locates the appropriate payout in one or more stored payout tables 900, 1000, based on the current reward level.” Therefore, we find that Walker teaches the claimed invention, but for “the combined knowledge-based bonus game with the underlying game of chance having a house advantage within a predetermined range.” Clearly, we find that it would have been obvious to one of ordinary skill in the art at the time of the invention for the casino to attempt to make a profit or at least make sufficient revenue for the gambling machines and games so as to pay its overhead costs. Therefore, we find that it would have been one of the paramount design considerations in formulating the payout tables of Walker to have allotted the payouts in the table so as to give the house an advantage of at least a predetermined amount or set value taking into consideration the worst case scenario if nothing else.

As evidence of the above concept of house advantage, we rely upon the individual teaching of Vancura, Martinez, or Kilby which the examiner has appended to the answer. Each of these references teaches the basic operational concepts of the casino and casino games and the need for the generation of an advantage to the house so as to generate operational income and a profit.

With respect to dependent claim 3, Walker teaches various alternative embodiments of the combined casino game where the two games are interleaved and where the two games are played sequentially. (See Walker at col. 11, line 15.) Therefore, we find that the combined teachings would have fairly suggested the invention as recited in dependent claim 3.

With respect to dependent claim 9, as discussed above, we find that the skilled artisan would have at least taken into consideration all trivia questions being answered correctly so as to give the house an advantage of at least a predetermined amount or set value taking into consideration the worst case scenario if nothing else. Therefore, we find that the combined teachings would have fairly suggested the invention as recited in dependent claim 9.

We have rejected independent claim 1 and dependent claims 3 and 9 as examples of the breadth of appellant's claims and the appropriateness of a rejection based upon obviousness rather than anticipation as made by the examiner. We leave it to the examiner to further evaluate the remainder of the claims and extend the rejection as is deemed appropriate.

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This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

## CONCLUSION

To summarize, the decision of the examiner to reject claims under 35 U.S.C. § 112, FIRST PARAGRAPH is reversed, the decision of the examiner to reject claims under 35 U.S.C. § 112, SECOND PARAGRAPH is reversed, the decision of the examiner to reject claims under 35 U.S.C. § 102 is reversed, and the decision of the

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examiner to reject claims under 35 U.S.C. § 103 is reversed. We have rejected claims 1, 3 and 9 under 35 U.S.C. § 103 under the authority under 37 CFR 41.50(b).

**REVERSED**

Joseph Ruggirello  
JOSEPH F. RUGGIRELLO

JOSEPH F. RUGGIERO  
Administrative Patent Judge



KIMBERLY DIXON

JOSEPH L. DIXON  
Administrative Patent Judge

*Frank B. Levy*

STUART S. LEVY  
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